

will produce results in a manner that will distinguish them from the non-relevant documents stored in EDGAR.

At Page 4, Lines 1-4 of the Office Action dated October 8, 2002, the Examiner stated that the concerned public could search EDGAR by using at least text and Boolean operators. The Examiner suggested that the terms would included “*mutual funds, allocation, allocate, industry, percent.*”

Responding to the Examiner’s suggestion, Applicant submitted with his Office Action of June 26, 2003 a first Declaration Under 37 C.F.R. §1.132, which described the results of a database search through a number of search engines. In the Office Action of June 2, 2004, the Examiner, at Page 43, Line 7 to Page 44, Line 3, finds this §1.132 Affidavit “not persuasive” because the terms of the argument were processed “one at a time” by one of the search engines. “The Examiner respectfully suggests the use of Boolean and proximity operators as well as date ranges in his searches for the words, alone or in combination with each other.” In particular, the Examiner suggests that, “Search terms may include such as *mutual, funds, stock, allocation, allocate, industry, percent, etc.*” Responding fully to the Examiner’s suggestion, the undersigned has secured and submits with this Supplemental Amendment a new, second Affidavit under §1.132.

Appreciating that the methodology used by the Examiner to locate the SEC Filing would be relevant to whether the SEC Filing is a publication under 35 USC §102, the undersigned has directed an associate to secure and search the file history of the subject application for any materials that might be descriptive of the search process employed by the Examiner. Our review of the file history indicates that the Examiner had requested that the Scientific Technical Information Center (STIC) of the U.S. Patent and Trademark Office (USPTO) to access the SEC Filing. To this end, the Examiner had developed a first search argument comprised of the name of the inventor and/or the name of Applicant’s invention, i.e., the “Industry Leaders Fund”, and a second argument comprising terms that relate to the content of the SEC Filing. As will be detailed below, only the first kind of argument was successful to access the SEC Filing. Applicant notes that the name of the Applicant and the name given by the Applicant to his invention are not publicly available. Therefore, a persons seeking access to the SEC document would not be aware of Applicant’s name or invention.

In particular, the Applicant's name and the name of his invention are disclosed in the subject application, which is held in secrecy by the USPTO. Thus, the Examiner would not as a matter of law be able to use such confidential information to search a database, i.e., EDGAR, for the SEC Filing.

The undersigned's review of the results of using the second kind of search terms failed to access the SEC Filing, despite the extensive search efforts made by the Examiner as detailed below. The failure of the Examiner to access the SEC Filing despite extensive searching conclusively shows that the SEC Filing was not a printed publication under 35 USC §102 because a person with skill and/or related to the financial subject matter described by the SEC Filing ("the skilled person") would be unable by employing only reasonable diligence to access the SEC Filing within the EDGAR or other databases.

As included within Exhibit A, the undersigned noted a search report dated November 20, 2003 from the STIC of the technology center 3600 to Etelka Griffin, which reported the results of its search on Westlaw and Lexis. As described at the bottom of this search report, the search sought to: "(a) find filings 1997-1999 with following information: Clairmont Investment Partners, Industry Leaders Fund, Gerald P. Sullivan, (b) search SEC Filings 1997-1999 with following words, Boolean/proximity operators: mutual fund(s) stock(s) allocation, allocate, by industry, percent, investment, universe total, industry total, etc." The only search results that appeared relevant in any way to this search request is a document, also included in Exhibit A, entitled "Search (Historical SEC EDGAR Archives)". This document included a window entitled "EDGAR Search: Enter a Search String" which appeared above a first box in which was entered the term "Industry Leaders" and a second box having a start date of "1998" and an end date of "1999". This document indicated that, "Your search matched 13 of 634572 documents and listed the titles of the 13 documents related to the "Industry Leaders Fund". Item number 11 is dated December 04, 1998 and could be the SEC Filing. The undersigned did not find any search results produced by the second search argument of the noted terms.

A second search was conducted and the results thereof were reported by a cover sheet dated November 25, 2003, entitled "STIC SEARCH REPORT" and addressed from an Elizabeth Deal to the Examiner of this application. This cover sheet and related documents

are enclosed as Exhibit B. A second sheet entitled, "MAIL-IT requested: November 26, 2003" and indicated that the search argument comprised "date BEF 2000 and (Gerald W/2 Sullivan) and Industry Leaders Fund". The second page indicated that the search produced 31 hits or "REPORTS". The search results also comprised pages 3 and 4, which identified the found documents. Documents 28 and 29 are dated December 4, 1998 and maybe the SEC Filing. Thus, the SEC Filing was potentially accessed by the use of a search argument which only included the confidential terms corresponding to the name of the inventor and of the name of the system described by the subject application.

A third search was reported by a page dated November 24, 2003 at its bottom and bore the initials E.K.D. (apparently referring to Elizabeth Deal), and included herewith as Exhibit C. The second page sets out five distinct search arguments, S1-S5 using various forms of "Gerad" (an apparent misspelling of the inventor's name – Gerald), ("industry or sector") and "fund". These arguments produced a few hits, but the narrowest argument S5 filed to produce a citation. The five hits from argument S4 were reproduced on pages 3 and 4 of Exhibit C. The undersigned's review of the five documents indicated that none were relevant to the SEC Filing. The Examiner's third report provides a clear showing that even the Examiner's argument, which included at least some terms that were related to the content of the SEC Filing, was not effective to access the SEC Filing.

A fourth search is described by a collection of 25 pages, each identified at the bottom by the date November 25, 2003 and the initials EKD, all of which are collected in Exhibit D. The first page identifies thirty search arguments S1-S30. Of these 30 arguments, S1-S5 are deemed basic, each producing over a million hits each. The terms include not only the names of the inventor and the system described in the subject application, but also the content of the SEC Filing. The terms of the arguments S1-S5 are "anded" together, before being "anded" in various combinations and date limited. The undersigned has reviewed pages 2 to 25, but failed to find the SEC Filing or any reference related thereto. The source of each of the citations is set out in the first line of the citation, e.g., the second or K/2 document on page 2 is identified as being derived from the DIALOG data base.

A fifth search is described by a document comprising twelve pages, which are enclosed herewith as Exhibit E. The fifth search uses arguments which are similar to the

fourth search but conducted in two different files. Six arguments, L1-L6 are listed on page one and primarily relate to the contents of the SEC Filing. The sixth search argument L6 narrowed the search to 44 hits, which are listed on pages 2-12 of Exhibit E. The undersigned has reviewed the documents listed on pages 2-12 and fails to find the SEC Filing or any document related thereto.

A sixth search is described by a document of 47 pages, which are identified as Exhibit F. The sixth search includes 35 arguments, which are listed on pages 1 and 2, and are similar to the arguments of the fourth search, but conducted on a different group of files. The results of this search were numbered in different ways and were printed out on pages 2-49. Again, the undersigned reviewed pages 2-49 without finding the SEC Filing and any document related thereto.

Thus, it is clear that the Examiner and STIC have failed to access the SEC Filing when they used terms that reflected the content of the SEC Filing. Applicant also notes that the Examiner and STIC used in their arguments the terms that the Examiner had listed in his January 2, 2004 Office Action and further had used Boolean and proximity operators in their search arguments and still failed to find the SEC Filing or a related document. A review of the search argument that was used in each of these searches clearly indicate the extensive effort, which exceeded the reasonable diligence established by the *Cronyn* decision of the Federal Circuit. Thus, the Applicant respectfully asserts that one skilled or knowledgeable about securities could not access the SEC Filing, even if that person used an unreasonable diligence. Therefore, the SEC Filing was not a printed publication under 35 USC §102(b).

Applicant had submitted by his June 26, 2003 Amendment a first Affidavit under 35 USC §132 which showed the results of a plurality of searches of different search engines and arguments. The first Affidavit was prepared by Travis L. Gering, an attorney experienced in security and financial matters.

At page 43, line 7 to page 44, line 3, of the Examiner's Office Action of January 2, 2004, he criticized this Affidavit stating, "The Examiner respectfully notes that Applicant's search would be greatly facilitated by not searching for each word one at a time. The Examiner respectfully suggests the use of Boolean and proximity operators, as well as date ranges in his searches for the words, alone or in combination with each other." The

Examiner specifically suggested the following search terms: “*mutual, funds, stock, allocation, allocate, industry, percent, etc.*”

Applicant submits by this Supplemental Amendment, a second Affidavit under 35 USC §132 by Travis L. Gering. The affiant conducted a further search on each of the following search engines: 1) FindLaw, 2) SEC EDGAR, 3) LEXIS/NEXIS, and 4) Google. Each search used one of the following terms: A) Mutual Funds, B) Stocks, C) Allocation, D) Allocate, E) Industry, and G) Percent. Further Mr. Gering conducted a further search on each of the above named search engines 1)-4) using a search argument, which was constructed by “anding” the above listed items A)-F). The searches on the FindLaw engine, the LEXIS/NEXIS engine and the Google search engine provided respectively 6,900 hits, over 3,000 hits and 16,500 hits. The search on the SEC EDGAR search engine revealed no hits. In a manner similar to the searching conducted by the Examiner and STIC, Mr. Gering’s search clearly proved that one skilled in or related to the subject matter of this search, i.e. financial and security matters, could not with reasonable diligence access the SEC Filing. Therefore, Applicant respectfully asserts that the SEC Filing is not a printed publication under 35 USC §102(b) and, therefore, may not be applied in the Examiner’s rejection of Applicant’s claim.

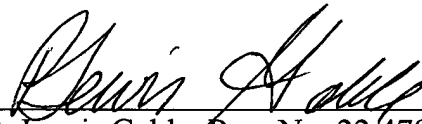
As clearly shown in the above discussion, the various searches of the databases and the failure to access the SEC Filing are clearly related to and evidence of whether the SEC Filing was a printed publication in accordance with 35 USC §102(b). The patent statutes clearly impose upon Applicant as well as the undersigned to be candid with the USPTO as to any reference that is material to the validity of the claims that Applicant would seek to be examined and issued. Applicant asserts that the Examiners have a similar fiduciary duty to bring to the attention of the public and the Applicant any reference or activity that would support the patentability of Applicant’s claims. In particular, Applicant respectfully asserts that the Examiner has a fiduciary duty to bring such matter, i.e., all of the searches and the results thereof, that would clearly bear upon the issue of whether or not a particular document was a printed publication within the meaning of 35 USC §102. Applicant notes that he has made considerable financial expenditures in the prosecution of this application

and asserts that if the Examiner's search activity was disclosed in an earlier Office Action, then there could have a significant decrease in the cost of prosecuting this application.

In summary, the Examiner has conducted at least 6 different searches as shown by the Exhibits A, B, C, D, E and F, each search including multiple search arguments, with out being able to access the SEC Filing. The Examiner has used the search facilities of the USPTO. Applicant respectfully asserts that the Examiner search effort far exceeds the reasonable diligence standard of *Cronyn* and still has not accessed the SEC Filing. Applicant respectfully asserts that the Examiner's own search and his failure to find the SEC Filing clearly establish that the SEC Filing is not a printed publication within the definition of 35 USC Section 102(b).

Applicant respectfully asserts that this application is now in condition for allowance, which action is respectfully requested. If the Examiner is unable to allow this application, he is requested to place a telephone call to the undersigned to suggest those amendments whereby the prosecution may be prosecuted to issuance.

Respectfully submitted,



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